



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,396	03/09/2001	Akira Nonaka	450100-03058	8707
20999	7590	10/21/2005	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			CANGIALOSI, SALVATORE A	
			ART UNIT	PAPER NUMBER

3621

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/803,396		NONAKA, AKIRA	
	Examiner		Art Unit	
	Salvatore Cangialosi		3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18,26,27 and 31-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18,26,27 and 31-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3621

1. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. Claims 1-18, 26-27, 31-35 are rejected under 35 U.S.C. § 103 as being unpatentable Ryan (5513260) in view of Blatter et al (5933500) alone or further in view of Hirai (6839503).

Regarding claim 1, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) substantially as claimed. The differences between the above and the claimed invention is the use of explicit control. It is noted that a committed content duplicator would control and examine files illicitly copied (and has done so since for at least a decade with the advent of peer to peer file sharing) and is therefore believed to be the functional equivalent of the claimed

Art Unit: 3621

limitations. Otherwise resort can be had to Blatter et al (Fig. 2). Hirai (See Figs. 1-2) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Regarding claim 2, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) substantially as claimed. The differences between the above and the claimed invention is the use of explicit authentication control. It is noted that a committed content duplicator would control and examine files illicitly copied (and has done so since for at least a decade with the advent of peer to peer file sharing) and is therefore believed to be the functional equivalent of the claimed limitations. Otherwise resort can be had to Blatter et al (Fig. 2). Hirai (See Figs. 1-2) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Regarding disabling limitations of claim 3, Hirai (See

Art Unit: 3621

Figs. 1-2) show reproduction and recording means with system control and encryption/authentication with copy prevention (See Col. 9, lines 55-65) (Note that each of the applied items of evidence prevents and thus disables illegal copying) that is a functional equivalent of the claimed limitations. Regarding disabling limitations of claim 4, Hirai (See Figs. 1-2) show reproduction and recording means with system control and encryption/authentication with copy prevention (See Col. 9, lines 55-65) (Note that each of the applied items of evidence prevents and thus disables illegal copying) that is a functional equivalent of the claimed limitations. Regarding the enabling limitations claim 5, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled(that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations. Regarding the enabling limitations claim 6, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled(that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations. Regarding disabling limitations of claim 7, Hirai (See Figs. 1-2) show reproduction

Art Unit: 3621

and recording means with system control and encryption or authentication with copy prevention (See Col. 9, lines 55-65) (Note that each of the applied items of evidence prevents and thus disables illegal copying) that is a functional equivalent of the claimed limitations. Regarding disabling limitations of claim 8, Hirai (See Figs. 1-2) show reproduction and recording means with system control and encryption/authentication with copy prevention (See Col. 9, lines 55-65) (Note that each of the applied items of evidence prevents and thus disables illegal copying) that is a functional equivalent of the claimed limitations. Regarding the enabling limitations claim 9, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled(that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations. Regarding the enabling limitations claim 10, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled(that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations. Regarding disabling limitations of claim 11, Hirai (See Figs. 1-2) show reproduction and recording means with system

Art Unit: 3621

control and encryption or authentication with copy prevention (See Col. 9, lines 55-65) (Note that each of the applied items of evidence prevents and thus disables illegal copying) that is a functional equivalent of the claimed limitations. Regarding disabling limitations of claim 12, Hirai (See Figs. 1-2) show reproduction and recording means with system control and encryption/authentication with copy prevention (See Col. 9, lines 55-65) (Note that each of the applied items of evidence prevents and thus disables illegal copying) that is a functional equivalent of the claimed limitations. Regarding the enabling limitations claim 13, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled(that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations. Regarding the enabling limitations claim 14, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled(that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations. Regarding disabling limitations of claim 15, Hirai (See Figs. 1-2) show reproduction and recording means with system control and encryption or

Art Unit: 3621

authentication with copy prevention (See Col. 9, lines 55-65)

(Note that each of the applied items of evidence prevents and thus disables illegal copying) that is a functional equivalent of the claimed limitations. Regarding disabling limitations of claim 16, Hirai (See Figs. 1-2) show reproduction and recording means with system control and encryption/authentication with copy prevention (See Col. 9, lines 55-65) (Note that each of the applied items of evidence prevents and thus disables illegal copying) that is a functional equivalent of the claimed limitations. Regarding the enabling limitations claim 17, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled(that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations. Regarding the enabling limitations claim 18, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled(that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations. Regarding claim 26, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a method for reproducing content (cd player), a recorder and means there between for

Art Unit: 3621

examining and controlling transfer (black boxes) substantially as claimed. The differences between the above and the claimed invention is the use of explicit control. It is noted that a committed content duplicator would control and examine files illicitly copied (and has done so since for at least a decade with the advent of peer to peer file sharing) and is therefore believed to be the functional equivalent of the claimed limitations. Otherwise resort can be had to Blatter et al (Fig. 2). Hirai (See Figs. 1-2) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Regarding the encryption limitations claim 27, Hirai (See Figs. 1-2) show reproduction and recording means with system control and encryption/authentication that is a functional equivalent of the claimed limitations. Regarding claim 31, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) substantially as claimed. The differences between the above and the claimed invention is the use of explicit control.

It is noted that a committed content duplicator would control and examine files illicitly copied (and has done so since for at

Art Unit: 3621

least a decade with the advent of peer to peer file sharing) and is therefore believed to be the functional equivalent of the claimed limitations. Otherwise resort can be had to Blatter et al (Fig. 2). Hirai (See Figs. 1-2) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Regarding the encryption limitations claim 32, Hirai (See Figs. 1-2) show reproduction and recording means with system control and encryption/authentication that is a functional equivalent of the claimed limitations. Regarding disabling limitations of claim 33, Hirai (See Figs. 1-2) show reproduction and recording means with system control and encryption/authentication with copy prevention (See Col. 9, lines 55-65) (Note that each of the applied items of evidence prevents and thus disables illegal copying) that is a functional equivalent of the claimed limitations. Regarding disabling limitations of claim 34, Hirai (See Figs. 1-2) show reproduction and recording means with system control and encryption/authentication with copy prevention (See Col. 9, lines 55-65) (Note that each of the applied items of evidence prevents and thus disables illegal copying) that is a functional equivalent of the claimed limitations. Regarding disabling

Art Unit: 3621

limitations of claim 35, Hirai (See Figs. 1-2) show reproduction and recording means with system control and encryption/authentication with copy prevention (See Col. 9, lines 55-65) (Note that each of the applied items of evidence prevents and thus disables illegal copying) that is a functional equivalent of the claimed limitations.

Examiner's Note: Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Applicants arguments dated 08/08/2005 have been considered but are not persuasive. The arguments are relying on data not part of any claim (. i.e. format conversion in background, pages 11-13 of the remarks). With respect to the examining means, Ryan must examine all claimed elements in order to record and conditional access is a usage based control. Blatter et al (Col. 2, lines 1-30) clearly show different fee structure for different use and thus different profits.

Art Unit: 3621

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Salvatore Cangialosi at telephone number **(571) 272-6927**. The examiner can normally be reached 6:30 Am to 5:00 PM, Tuesday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached at **(571) 272-6712**.

Any response to this action should be mailed to:

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Serial Number: 09/803,396

12

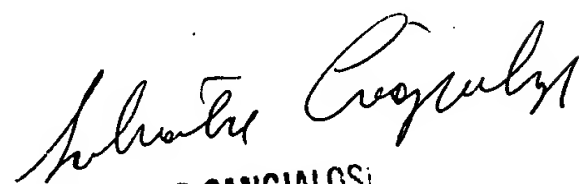
Art Unit: 3621

or faxed to (703)872-9306

Hand delivered responses should be brought to

United States Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SALVATORE CANGIALOSI
PRIMARY EXAMINER
ART UNIT 222